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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,326	11/23/2001	Anthony Derosé	PT-1475000	2546

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EXAMINER

SILBERMANN, JOANNE

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 12/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

990326

Applicant(s)

Derose

Examiner

Silbermann

Group Art Unit

3611

**The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9-19-03.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-9, 12-16, 21-29, 31-43 is/are pending in the application.
- Of the above claim(s) 29 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-9, 12-16, 21-28, 31-43 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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**DETAILED ACTION**

***Election/Restrictions***

1. Newly amended claim 29 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the light sources are not contained within an edge of the sign.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 29 (and 39 and 43 as dependent therefrom) withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how a sign, as in claim 40, having a concave reflective panel can further include a reflective panel that is concave, convex or flat. These panels cannot be understood at this time.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-7, 12, 13, 15, 21, 22, 27, 31, 34-36, 39 (as dependent from 1, 12, 21, 27, 34 and 35) and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Giuliano et al.

6. Giuliano et al. teach an ornament comprising a body panel 10 made of plastic having sides and an etched surface 10a with a design 12 (Figures 1 and 2). This design may be any non-random image (column 2 line 22). Opening 11 in one side of the body holds light emitting diode 1 by means of transparent material 2. A plurality of light sources may be used. The body panel may be colored and may include a mirrored surface. Giuliano et al. also disclose a switching/timer device for operating the display.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3, 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Ming-ho.

9. Giuliano et al. do not specifically teach a Christmas ornament, Santa Claus, crucifix or heart, however, Ming-ho teaches a variety of ornaments and structures, as discussed in column 14 lines 37-53.

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10. Claims 8 (and 39 as dependent therefrom) and 9 are rejected under 35 U.S.C.

103(a) as being unpatentable over Giuliano et al. in view of Lee.

11. Giuliano et al. do not teach supporting rails in a housing, however, Lee teaches a housing 1 with one rail structure 12 at the top of the sign. Providing another similar rail structure at the bottom of the sign and separated to receive the display would have been obvious to a person having ordinary skill in the art. Lee further teaches light emitting diodes located in the rail structure.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Dimmick, US #5,151,679.

13. Giuliano et al. do not teach the secondary light scattering elements as being shavings or bubbles, however, this is well known in the art. Dimmick teaches an illuminated sign including light scattering means comprising bubbles (column 4 lines 67-68). It would have been obvious to a person having ordinary skill in the art to utilize bubbles as a light scattering means (as shown by Dimmick) to provide additional, increased illumination for the display.

14. Claims 16, 23-26, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Volland.

15. Giuliano et al. do not teach a string of ornaments, however, Volland teaches string 14 of ornaments 15. The ornaments are different sizes and shapes. It would have been obvious to one of ordinary skill to utilize a string of ornaments to provide a larger, more aesthetically pleasing display.

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16. Claims 33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Day et al.

17. Giuliano et al. do not teach using the illumination in a necklace, however, this is well known in the art as shown by Day et al. It would have been obvious to one of ordinary skill to utilize the illumination of Giuliano et al. in forming a necklace so as to provide an illuminated pendant, as is discussed by Day et al.

18. Claims 40 and 41, as best as can be understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Oda et al.

19. Giuliano et al. do not teach a concave reflective panel, however, such panels are well known in the art of signs. Oda et al. teach a sign having illumination and concave reflector 5. It would have been obvious to one of ordinary skill to utilize such a reflector so as to provide more illumination from the light sources.

### ***Response to Arguments***

20. Applicant's arguments filed September 19, 2003 have been fully considered but they are not persuasive.

21. Applicant argues that Giuliano et al. do not teach an ornament, however, the examiner disagrees. Any display, sign or decorative object is considered to be an ornament.

22. Applicant argues that the references do not show a sign used in a store window or for emergency purposes, however, the intended use of a sign does not provide any structure. These uses have been considered, however, they are not given patentable weight.

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23. Regarding Volland, Applicant argues that the device shown is not an ornament. Again, the examiner disagrees. The individual articles in Volland are considered to be ornaments.

### ***Conclusion***

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 703-308-2091. The examiner can normally be reached on Tu-Th 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
Joanne Silberman  
Primary Examiner  
Art Unit 3611

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